

C. APPLICANT'S COMMENTS

Claims 1-17 are pending in this Application, with Claim 4 being amended and Claims 18-20 being added. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 1-17 and favorable consideration of Claims 18-20 is respectfully requested. The Examiner's rejections will be considered in the order of their occurrence in the Official Action.

Paragraph 1 of the Office Action

The Office Action objected to the drawings because reference numeral 50 pointed to a pipe instead of the dry chamber. The Applicant has corrected Figure 1 which is attached hereto.

Paragraph 2 of the Office Action

The Office Action objected to Claim 3 because "Claim 3 states the coolant system is positioned within the wet chamber." It appears that the Examiner intended the objection to apply to Claim 4 instead which has this limitation and the Applicant has therefore amended dependent Claim 4 accordingly.

Paragraph 3 of the Office Action

i. Overview

The Official Action rejected Claims 1-17 under 35 U.S.C. §103(a) as being unpatentable over Young et al. (WO 01/01741) in view of Roberts et al. (U.S. Publication No. 2005/0001334). The Applicant respectfully disagrees with this rejection of these claims.

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). When references cited by the Examiner fail to establish a prima facie case of obviousness, the rejection is improper and will be overturned upon appeal. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). "To support the conclusion that the claimed invention is directed to obvious

directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

“To establish a prima facie case of obviousness, three basic criteria must be met.” MPEP §706.02(j). First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The law regarding *obviousness* is clear -- any modification of the prior art must be suggested or motivated by the prior art. It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person*." Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

ii. Claims 1-20 Are Not Obvious In View Of Young And Roberts

First, there is **no suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Young or to combine reference teachings. First, neither of the references teaches a separate wet chamber and a separate dry chamber within a chassis. Second, the single panel in Young is used to provide access to both wet chambers (i.e. there is no need to have two doors since they are both wet chambers so they both are just exposed to the outside air at the same time). There simply is no suggestion or motivation in the references to modify Young to include a second door for the second chamber since the second chamber is already a wet chamber that simply stores the coolant used in the first chamber.

Second, there is **no reasonable expectation of success** of combining the two references. Young teaches two wet chambers (it does not appear the two chambers are sealed from one another in Young) while Roberts teaches a swamp cooler with two portions fluidly connected to one another. Attaching a panel as shown in Roberts to the second compartment in Young would not result in a "dry access door" since the second door would only be selectively covering a second wet chamber.

Finally, the prior art references when combined do **not must teach or suggest all the claim limitations**. The first missing claim limitation is the “dry chamber.” Independent Claims 1 and 11 both include the limitation of “a chassis having a wet chamber and **a dry chamber**.” As discussed in the interview, Young fails to teach the use of a dry chamber. More particularly, the Applicant stated that Young did not have a dry chamber since Young merely teaches a spray chamber (24) and a “coolant supply chamber (26)” which are both wet chambers. (Young, Figure 3 and Pages 6-7.) The Applicant further stated that the coolant supply chamber (26) in Young is for storing coolant which is pumped via the pump (36) wherein the coolant is collected by the sumps (42, 44) in both of the chambers (24, 26). (Young, Figure 3 and Pages 6-7.)

The second missing claim limitation is the “dry access door.” Independent Claims 1 and 11 both include the limitation of “a dry access door removably attached about said dry chamber.” Young merely teaches a single cover (32) that is removably attached to the chassis for covering both wet chambers. (Young, Figure 1). Roberts merely teaches a swamp cooler that does not have separate defined chambers, so there can be no door that provides access to only a single chamber since by opening either panel in Roberts provides access to the other chambers.

iii. Roberts is Non-Analogous

The Applicant respectfully submits that Roberts is non-analogous to the present invention. More particularly, Roberts is a **swamp cooler** designed to provide cost effective air conditioning to the interior air of a house. The present invention is in the field of **thermally managing electronic devices** such as microprocessors, circuit boards and the like. For example, both independent Claims 1 and 11 require the feature of a wet chamber “for thermally managing an electronic device by applying liquid coolant to an electronic device within said wet chamber.”

“The determination that a reference is from a non-analogous art is . . . twofold. First, we decide if the reference is **within the field of the inventor’s endeavor**. If it is not, we proceed to determine whether the reference is **reasonably pertinent to the particular problem with which the inventor was involved**.” *In re Wood*, 202 USPQ 171, 174 (C.C.P.A. 1979). “A reference is **reasonably pertinent** if . . . it is one which, because of the matter with which it deals, logically

would have commended itself to the inventor's attention in considering his problem. . . . If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, . . . [i]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it." *In re Clay*, 23 USPQ 2d 1058, 1060–61 (Fed. Cir. 1992).

First, Roberts is not within the field of the inventor's endeavor (i.e. swamp coolers versus thermal management devices for thermally managing electronic devices). Second, Roberts is not reasonably pertinent to the particular problem with which the inventor was involved (i.e. providing access to only the dry chamber without having to expose the wet chamber to the exterior air.¹

The Applicant also respectfully submits the following case law in support that the prior art stated in the Official Action is non-analogous:

- "In resolving the question of obviousness under 35 USC 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. . . . The rationale behind this rule precluding rejections based on combination of teachings of references from nonanalogous arts is the realization that an inventor could not possibly be aware of every teaching in every art." *In re Wood*, 202 USPQ 171, 174 (C.C.P.A. 1979).
- "In the instant application, the examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements. That is to say, appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. . . . Based upon the record before us, we are convinced that the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide. It

¹ Roberts merely teaches the usage of an access panel to access a portion of the swamp cooler and would not result in the structure/function of the present invention.

is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness.” *Ex parte Clapp*, 227 USPQ 972, 973 (B.P.A.I. 1985).

- “We have reminded ourselves and the PTO that it is necessary to consider “the reality of the circumstances” . . . — in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” *In re Oetiker*, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).
- “The Allen-Bradley art is not in the same field of endeavor as the claimed subject matter merely because it relates to memories. It involves memory circuits in which modules of varying sizes may be added or replaced; in contrast, the subject patents teach compact modular memories. . . . Wang’s SIMMs were designed to provide compact computer memory with minimum size, low cost, easy repairability, and easy expandability. . . . In contrast, the Allen-Bradley patent relates to a memory circuit for a larger, more costly industrial controller. . . . Thus, there is substantial evidence in the record to support a finding that the Allen-Bradley prior art is not reasonably pertinent and is not analogous.” *Wang Labs., Inc. v. Toshiba Corp.*, 26 USPQ 2d 1767, 1773 (Fed. Cir. 1993).

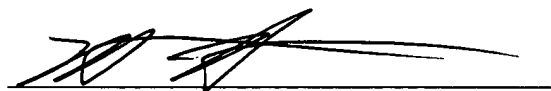
iv. Summary

For these reasons, among others, the combination of Young with Roberts cannot suggest the combination of features in applicant’s Claims 1-20, and it is therefore submitted that the rejection against these claims should be withdrawn and Claims 1-20 allowed.

D. CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

Respectfully submitted,



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